

**REMARKS**

This is in response to the non-final Office Action of Paper No. 13 dated June 1, 2004. Claims 1-18 and 32-43 are pending in the application. It is respectfully requested that the application be reconsidered and these claims allowed.

**Amended Claim 7 Satisfies the Requirements of 35 U.S.C. §112, Second Paragraph:**

The Office Action states that, in claim 7, the limitation “said desirable number” lacks sufficient antecedent basis. Applicant has amended claim 7 so that it now depends from claim 6, rather than from claim 1. Claim 6, in turn, depends from claim 41. Claims 6 and 41 provide proper antecedent basis for the limitation “said desirable number” contained in amended claim 7. Therefore, Applicant submits that the rejection of claim 7 under 35 U.S.C. §112, second paragraph, has been overcome.

**The Claims Are Patentable Over Griner et al. Considered In View of Walker et al.**

Claims 1-5, 8-18, 32-38, 40 and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Griner et al. considered in view of Walker et al. Specifically, the Office Action alleges that “Griner et al. shows all of the limitations of the claims except for specifying a POS and the opportunity for prospective event ticket purchasers to pre-purchase a recording copy.” The Office Action further alleges that “Walker et al. teaches, [at] column 17, lines 55-63, POS terminals where the actual functions that are to affect transactions may be set [by] merchants such as pre-purchased discounts as purchasing incentives and the like in order to increase revenue (a POS and the opportunity for prospective event ticket purchasers to pre-purchase a recording copy)<sup>1</sup>.” Based on this premise, the Office Action concludes that it would have been obvious to one of ordinary skill in the art to modify the Griner et al. system to

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<sup>1</sup> As explained later in this response, Applicant respectfully submits that there is a critical disconnect in this statement, which results in a false premise on which the Office relies in reaching its conclusion.

incorporate the POS system of Walker et al. in order to increase revenue. For reasons explained below, Applicant respectfully disagrees with both the premise and the conclusion.

### **Claim 1**

It is respectfully submitted that claim 1 is patentable over Griner et al. and Walker et al., because (1) there is no teaching or suggestion contained in either reference that would have motivated one skilled in the art to combine their teachings to create the claimed invention, and (2) even if combined, the teachings of Griner et al. and Walker et al. still fall short of the claimed invention.

#### **(1) No Teaching or Suggestion to Combine Griner et al. and Walker et al.**

The statutory standard for the ultimate determination for obviousness provides that a claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Brown & Williamson Tobacco Corp. v. Phillip Morris Inc., 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000). A showing of a suggestion, teaching or motivation to combine the prior art references is an essential evidentiary component for an obviousness holding. C. R. Bard, Inc. v. M3 Sys., Inc., 48 U.S.P.Q.2d 225, 232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, but the [Office Action] must identify specifically the reasons one of ordinary skill in the art would have been motivated to select the references and combine them. In re Rouffet, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). The Office Action can satisfy the burden of obviousness in light of a combination only by showing some objective teaching leading to the combination. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the invention's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. Graham v. John Deere Co., 148 U.S.P.Q. 459, 467 (1966). "To imbue one of ordinary skill in the art with the knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight

syndrome wherein that which only the inventor taught is used against teacher." W. L. Gore & Assoc. v. Garlock, Inc., 220 U.S.P.Q. 203, 312-313 (Fed. Cir. 1983).

Claim 1 recites, in pertinent part, the step of "providing, at a point-of-sale of tickets for a live performance event before said live performance event occurs, an opportunity for prospective event ticket purchasers to pre-purchase one or more copies of a recording of at least a portion of said live performance event..."

The Office Action acknowledges that Griner et al. fails to disclose a POS and the opportunity for prospective event ticket purchasers to pre-purchase a recording copy, and Applicant agrees. This is because the Griner et al. invention relates to high-technology equipment used for creating multiple recordings of an event simultaneously, so that copies can be made available to event attendees shortly after the event has ended. The Griner et al. technology accomplishes this in two ways. First, as the event is being recorded live, an editing module parses a primary event file into multiple "discrete slices" which can each be edited individually and then copied to recording media as each track or "slice" becomes available. Thus, copying the edited tracks to CD or other recording media (in sequence as they become available) can begin while the event is still being conducted and recorded. Second, Griner et al. discloses the use of multiple CD burners working in parallel, copying the edited tracks to multiple CDs, which will then be made available to event attendees shortly after the event has ended. Thus, the teachings of Griner et al. are limited to solving the problem of how to make numerous copies of the event recording available as soon as possible following conclusion of the event. Griner et al. does not disclose, teach or suggest any manner of marketing or selling the recordings, and certainly does not disclose, teach or suggest "providing, at a point-of-sale of tickets for a live performance event before said live performance event occurs, an opportunity for prospective event ticket purchasers to pre-purchase one or more copies of a recording of at least a portion of said live performance event..." as required by claim 1.

Walker et al. discloses a system and method for establishing and executing functions to affect credit card accounts and transactions. The "functions" referenced throughout the Walker et al. specification are said to include "discounts, dollars off, incentive interest rates (e.g., no interest for 6 months), rebate due, or inclusion of customer-specified text based

messages (e.g., message codes or personal accounting codes which are retrieved at a point-of-sale and which are to appear on a monthly credit card billing statement).” The entire specification of Walker et al. relates to use of the disclosed system and method for establishing and executing such “functions” in the context of credit card transactions.

The Office Action focuses on lines 55-63 in column 17 of Walker et al., which state:

“[T]he actual functions that are to affect transactions may be set by merchants such as pre-purchased discounts as purchasing incentives and the like, by customers desiring to record transaction information such as text strings and the like, and by credit card issuers as incentives to utilize and/or activate credit card accounts. In any event, the functions contemplated by the present [invention] are intended to be processed utilizing conventional and readily available point-of-sale processing systems that allow for entry of alpha and numeric data.”

The Office Action alleges that this excerpt from Walker et al. teaches “a POS and the opportunity for prospective event ticket purchasers to pre-purchase a recording copy” (refer to the first full paragraph of page 3 of the Office Action). However, Applicant respectfully submits that there is a critical disconnect between this excerpt from Walker et al. and the Office Action’s apparent interpretation of what it discloses or teaches. Applicant does not deny that the system and method of Walker et al. may be put into use at a retail “point-of-sale.” However, nothing in this excerpt (or anywhere else in the specification) of Walker et al. discloses or teaches a method comprising the step of “providing, at a point-of-sale of tickets for a live performance event before said live performance event occurs, an opportunity for prospective event ticket purchasers to pre-purchase one or more copies of a recording of at least a portion of said live performance event...” as claimed.

Walker et al. has nothing to do with the sale of tickets for a live performance event, and certainly does not teach a method of giving prospective event ticket purchasers an opportunity to pre-purchase a recording of the event at the POS of tickets before the live performance event occurs.<sup>2</sup> The Office Action relies on the premise that this excerpt of Walker et al. teaches “a POS and the opportunity for prospective event ticket purchasers to pre-purchase a recording copy” in order to reach the conclusion that it would have been obvious to one of ordinary skill in the art to modify the Griner et al. system to incorporate the POS system of Walker et al. However, for reasons explained above, this is a false premise.

In light of the above, Applicant respectfully submits that the Office Action provides no evidence of an objective teaching in either Griner et al. or Walker et al. that would have motivated one of ordinary skill in the art to combine these references. Accordingly, Applicant respectfully submits that the rejection is improper and should be withdrawn.

(2) Even if Combined, Griner and Walker Fail to Disclose the Claimed Invention

Even if the teachings of Griner et al. and Walker et al. were combined (which Applicant submits is an improper combination for the reasons stated in the previous section of this response), the combination still falls short of disclosing all of the claimed features of the invention. Again, the Office Action has already acknowledged that Griner et al. fails to disclose a POS and the opportunity for prospective event ticket purchasers to pre-purchase a recording copy, and Applicant has further noted that Griner et al. fails to disclose such opportunity being made available “before the live event occurs.” For reasons stated in the previous section of this response, Applicant respectfully submits that Walker et al. does not make up for the shortcomings of Griner et al. because it does not disclose, teach or suggest a method of giving prospective event ticket purchasers an opportunity to pre-purchase a recording of the event at the POS of tickets before the live performance event occurs.

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<sup>2</sup> With all due respect, Applicant suspects that the referenced excerpt from Walker et al. may have been identified during examination because it contains certain terms (i.e., “pre-purchased,” “record,” and “point-of sale”), which are used throughout Applicant’s disclosure and claims, and which would seem to be logical choices for a text-based computer search of the prior art. Aside from the common occurrences of these “buzz words” in Walker et al. and in Applicant’s claims, Applicant submits that Walker et al. is not relevant to the claimed invention.

For all of the foregoing reasons, Applicant respectfully submits that Claim 1 is patentable over the cited references.

**Claims 2-5 and 8-12**

Claims 2-5 and 8-12 depend from claim 1 and are therefore believed to be patentable over the Griner et al. and Walker et al. references for the same reasons as claim 1 discussed above.

**Claims 13-18**

Like Claim 1, Claim 13 recites, in pertinent part, the step of “providing, at a point-of-sale of tickets for a live performance event before said live performance event occurs, an opportunity for prospective event ticket purchasers to purchase one or more copies of a recording of said live performance event...”.

For the same reasons discussed above in connection with the analysis of Claim 1, Applicant respectfully submits that Claim 13 is not made obvious by Griner et al. and Walker et al. Again, Applicant respectfully submits that Claim 13 is patentable over these references because (1) there is no teaching or suggestion contained in either reference that would have motivated one of ordinary skill in the art to combine their teachings to create the claimed invention, and (2) even if combined, the teachings of Griner et al. and Walker et al. still fall short of the claimed invention. Therefore, Applicant respectfully submits that Claim 13 is patentable over the cited references.

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Claims 14-18 depend from Claim 13 and are therefore believed to be patentable over the Griner et al. and Walker et al. references for the same reasons as Claim 13 discussed above.

**Claims 32-38, 40 and 43**

Like Claims 1 and 13, independent Claim 32 recites, in pertinent part, the step of “providing, at a point-of-sale of tickets for a live performance event, and opportunity for attendees of the live performance event to purchase one or more copies of a recording of said live performance event”. Once again, Applicant respectfully submits that the claimed invention is patentable over Griner et al. and Walker et al. because (1) there is no teaching or suggestion contained in either reference that would have motivated one of skill in the art to combine their teachings to create the claimed invention, and (2) even if combined, the teachings of these references still fall short of the claimed invention. The arguments and observations recited above in conjunction with the analysis of Claim 1 are incorporated herein by reference. Accordingly, Applicant respectfully submits that Claim 32 is patentable over the cited references.

Claims 33-38, 40 and 43 all depend from Claim 32 and are therefore believed to be patentable over the Griner et al. and Walker et al. references for the same reasons as Claim 32 discussed above.

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**The Claims Are Patentable Over Griner et al., Considered In View of Walker et al., and Further In View of Stonedahl**

Claims 6, 7, 39 and 41-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Griner et al. considered in view of Walker et al., and further in view of Stonedahl. Specifically, the Office Action states that the combination of Griner et al. and Walker et al. shows all of the limitations of the claims, except for specifying the steps of determining and calculating the number of copies of the recording. This presumes that the previous claim rejections based on only Griner et al. and Walker et al. were valid ones. For the reasons discussed above in conjunction with the rejection of Claims 1-5, 8-18, 32-38, 40 and 43, Applicant respectfully submits that the combination of Griner et al. and Walker et al. *does not* in fact show all of the limitations of the claims other than what is allegedly disclosed in Stonedahl.

As discussed above, Applicant submits that independent Claims 1, 13 and 32 are all patentable over the Griner et al. and Walker et al. patents. Because Claims 6, 7, 39 and 41-42 depend from these claims, Applicant respectfully submits that they are patentable over Griner et al., Walker et al. and Stonedahl for the same reasons as Claims 1, 13 and 32 discussed above.

**Conclusion**

In light of the above, Applicant respectfully submits that the pending claims are in condition for allowance, and notification to that effect is earnestly solicited. The Examiner is

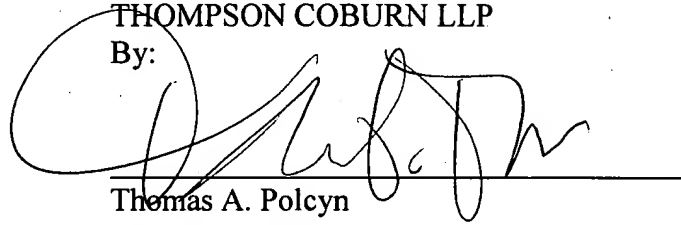


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invited to contact the undersigned by telephone at (314) 552-6331 if there are any questions or if it may otherwise facilitate the efficient prosecution of this case.

Respectfully submitted,  
THOMPSON COBURN LLP

By:

A handwritten signature in black ink, appearing to read 'T. Polcyn', is written over a horizontal line. The signature is stylized with large loops and a long horizontal stroke extending to the right.

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